

REMARKS

Applicant has reviewed and considered the Office Action mailed on July 29, 2009, and the references cited therewith.

Claims 36 and 40 are amended, and no claims are canceled or added; as a result, claims 1-3, 7, 8, 10-12, 30-33, and 35-42 are now pending in this application.

35 USC § 112 Rejection of the Claims

Claims 31-33 and 35-42 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 36 and 40 have been amended in accordance with the examiner's suggestions. Accordingly, applicants believe this rejection has been overcome with respect to claims 36 and 40-42.

Applicants traverse this rejection with respect to claims 31-33, 35, and 37-39. The examiner takes the position that claims 31 and 37 are indefinite because “[t]he fuel cell is external to the computer so the electronic system cannot ‘comprise’ the computer.” Applicants respectfully disagree.

Claim 31

Claim 31 depends from claim 30 and adds the limitation “wherein the electronic system comprises a computer.” Applicants respectfully submit that the scope of claim 31 encompasses embodiments in which the fuel cell is external to the computer as well as embodiments in which the fuel cell is internal to the computer. Figure 7 of the instant application shows a fuel cell 710 external to a computer, and Figures 8 and 9 shows fuel cells (810, 910) that are internal. Applicants respectfully submit that the scope of claim 31 encompasses embodiments represented by all of Figures 7-9.

The examiner takes the position that claim 31 is limited to embodiments in which the fuel cell is external to the computer. Applicants respectfully disagree for the reasons stated in the previous paragraph. Assuming, *arguendo*, that claim 31 is limited as the examiner suggests, applicants still maintain that claim 31 would be definite within the meaning of 35 USC § 112, second paragraph. The further recitation of “computer” does not render the claim indefinite.

Claims 32 and 33

Claims 32 and 33 depend from claim 31. Claim 32 narrows the claimed scope to embodiments in which the fuel cell is external to the computer, and claim 33 narrows the claimed scope to embodiments in which the fuel is in a swappable bay of the computer. Applicants respectfully submit that these claims are definite within the meaning of 35 USC § 112, second paragraph.

Claim 37

Claim 37 depends from claim 36 and adds the limitation “wherein the electronic system comprises a computer.” Applicants respectfully submit that the scope of claim 37 encompasses embodiments in which the fuel cell is external to the computer as well as embodiments in which the fuel cell is internal to the computer. Figure 7 of the instant application shows a fuel cell 710 external to a computer, and Figures 8 and 9 shows fuel cells (810, 910) that are internal. Applicants respectfully submit that the scope of claim 37 encompasses embodiments represented by all of Figures 7-9.

The examiner takes the position that claim 37 is limited to embodiments in which the fuel cell is external to the computer. Applicants respectfully disagree for the reasons stated in the previous paragraph. Assuming, *arguendo*, that claim 37 is limited as the examiner suggests, applicants still maintain that claim 37 would be definite within the meaning of 35 USC § 112, second paragraph. The further recitation of “computer” does not render the claim indefinite.

Claims 38 and 39

Claims 38 and 39 depend from claim 37. Claim 38 narrows the claimed scope to embodiments in which the fuel cell is external to the computer, and claim 39 narrows the claimed scope to embodiments in which the fuel is in a swappable bay of the computer. Applicants respectfully submit that these claims are definite within the meaning of 35 USC § 112, second paragraph.

35 USC § 103 Rejection of the Claims

Claims 1-3, 7, 8, 10-12, 30-33 and 35-42 were rejected under 35 USC § 103(a) as being unpatentable over Parr et al. (U.S. Patent No. 6,887,606) in view of Fukazu et al. (U.S. Publication No. 2002/0011327). Applicants respectfully traverse this rejection on the basis that a *prima facie* case of obviousness has not been presented because the combination of references fails to teach the claimed invention.

Applicants respectfully submit that the cited references fail to teach the subject matter of claim 1, including for example, “means for controlling an operating frequency of the microprocessor in response to the temperature.” Accordingly, applicants respectfully request that the rejection of independent claim 1 be withdrawn.

Applicants respectfully submit that the cited references fail to teach the subject matter of claim 30, including for example, “means for controlling a voltage provided to the integrated circuit in response to the temperature.” Accordingly, applicants respectfully request that the rejection of independent claim 30 be withdrawn.

Applicants respectfully submit that the cited references fail to teach the subject matter of claim 36 as amended, including for example, “a controller coupled to the integrated circuit to control a voltage provided to the integrated circuit in response to the temperature.” Accordingly, applicants respectfully request that the rejection of independent claim 36 be withdrawn.

Applicants respectfully submit that the cited references fail to teach the subject matter of claim 40 as amended, including for example, “a controller coupled to the microprocessor to control an operating frequency of the microprocessor in response to the temperature.” Accordingly, applicants respectfully request that the rejection of independent claim 1 be withdrawn.

The examiner has refused to give patentable weight to valid limitations

Four independent claims are currently pending. Two include a means-plus-function limitation and two do not. The examiner has refused to give patentable weight to at least one clause in each independent claim.

Means-plus-function claims

Independent claims 1 and 30 each include a means-plus-function limitation. The examiner and applicants are in agreement that 35 USC § 112, sixth paragraph has been invoked; however, the examiner refuses to give patentable weight to “in response to the temperature”.

Referring now to claim 1, the limitation in question reads:

means for controlling an operating frequency of the microprocessor in response to the temperature.

Applicants respectfully submit that the entire phrase “controlling an operating frequency of the microprocessor in response to the temperature” is functional language that modifies “means for”. Stated differently, the function of the means is to control a frequency in response to a temperature. Applicants respectfully submit that the examiner does not have valid grounds to deny patentable weight to a portion of the function.

Referring now to claim 30, the limitation in question reads:

means for controlling a voltage provided to the integrated circuit in response to the temperature.

Applicants respectfully submit that the entire phrase “controlling a voltage provided to the integrated circuit in response to the temperature” is functional language that modifies “means for”. Stated differently, the function of the means is to control a voltage in response to a temperature. Applicants respectfully submit that the examiner does not have valid grounds to deny patentable weight to a portion of the function.

Claims 7 and 8 have been treated similarly. The examiner has refused to give patentable weight to “in response to the temperature sensed by the temperature sensor”. Applicants respectfully submit that the entire recited function in claims 7 and 8 should be given patentable weight.

Non means plus function claims

Independent claims 36 and 40 are non means-plus-function claims and do not invoke 35 USC § 112, sixth paragraph.

Regarding claim 36, the examiner has refused to give patentable weight to “coupled to control a voltage to the integrated circuit in response to the temperature”. Regarding claim 40, the examiner has refused to give patentable weight to “coupled to control an operating frequency of the microprocessor in response to the temperature”. The examiner has refused to give patentable weight to these limitations because, in the examiner’s words, “Applicant is not claiming a method of operating an electronic system”.

Applicants respectfully submit that limitations in question are structural and should be given patentable weight.

Full patentable weight should be given to at least either the means-plus-function claims or the non-means-plus-function claims

Applicants respectfully submit that the examiner is treating the limitations as structural when considering the means-plus-function claims, and functional when considering the non-means-plus-function claims. Applicants respectfully submit that if the limitations in question are functional, then full patentable weight should be given to the means-plus-function claims. In the alternative, if the limitations are not functional, then full patentable weight should be given to the non-means-plus-function claims.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (952-473-8800) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-4238.

Respectfully submitted,

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By their Representatives,

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Date October 29, 2009 By /Dana B. LeMoine/
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